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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,957	02/09/2004	Gerald McRobbie	418198002US	8773

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EXAMINER
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LUONG, SHIAN TINH NHAN

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/774,957

Applicant(s)

MCROBBIE, GERALD

Examiner

Shian T. Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/14/05, 12/7/03</u> | 6) <input type="checkbox"/> Other: ____  |

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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2. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/641612.

Although the conflicting claims are not identical, they are not patentably distinct from each other. For double patenting to exist as between the claims, it must be determined that the rejected claims in this application are not patentably distinct from the claim in the copending application. In order to make this determination, it first must be determined whether there are any differences between the rejected claims and the claim in the copending application and, if so, whether those differences render the claims patentably distinct.

Claim 1 recites an “A beverage container lid, comprising: a thin, flexible body including a snap-fit retainer configured to engage a lip of a container, a support surface, and an opening in the support surface through which a fluid can flow; and an information member including a first surface juxtaposed and coupled to the support surface, a second surface opposite the first surface, and indicia on the first and/or second surface.” (see lines 1-9 of claim 1 of the copending application).

It is clear that all the elements of claim 1 are to be found in claim 1 of the copending application. The difference between claim 1 of the application and claim 1 of the copending application of the patent lies in the fact that the copending claim includes more elements and is thus more specific. Thus the invention of claim 1 of the copending application is in effect a “species” of the “generic” invention of claim 1. It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claim 1 is anticipated by claim 1 of the copending application, it is not patentably distinct from claim 1.

As to claim 14, it shares similar limitation and covered by claim 28 of the copending claim.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Information Disclosure Statement***

3. The information disclosure statement filed on 4/14/05 and 12/7/04 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The non-patent literature documents referred to therein has not been considered.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 6, 14-16, 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Melton (US 2002/0074337). Melton discloses a beverage container lid with a snap-fit retainer configured to engage a lip of a container. A support surface and an opening in the support surface as shown in Figures 1-6A. An information member such as an insert has first surface juxtaposed and coupled to the support surface, a second surface opposite the first surface, and indicia on the first and/or second surface. The opening is defined by a plurality of tabs

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configured to flex as shown in Figures 4-6A. The opening is generally circular. The opening is in the outer region of the support surface s shown in Figure 5. As shown in Figures 5-6A, the support surface is a recessed support surface and the body does not include other recesses.

6. Claims 7-11,13, 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Melton (US 2002/0074337). Melton discloses in the background of the invention that thermoformed plastic disposable food container and cup lids have printed, adhesive-backed stickers on the top surface to enhanced the appearance of the cup lid. As shown in the drawing, the support surface has a generally circular opening with tabs to flex as a straw is inserted in the opening. The opening is on the outer region of the body. The support surface is a recessed support surface and the body does not include other recesses.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5,12,17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melton in view of Wolf (US 3,392,468). Melton does not disclose a plurality of flexible buttons.

However, Wolf teaches a means in a cup lid to enable a vender to conveniently indicate to a customer the contents of the cup. Wolf has a plurality of flexible dimple 18 that is deformable.

The flexible dimples have indicia thereon to indicate the content. Therefore, it would have been

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obvious in view of Wolf to provide a plurality of dimples or buttons on the cup lid to indicate to the customer the contents within the cup.

9. Claims 1-4,6-11,13-16,18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills (US 4,502,608) in view of Melton or Crum and/or Hendler et al. Mills discloses a disposable drinking cup lid with a recessed support surface and an opening on an outer portion of the support surface. The opening is formed by a plurality of tabs. Mills does not show an informational member. However, Melton discloses in the background of the invention that thermoformed plastic disposable food container and cup lids have printed, adhesive-backed stickers on the top surface to enhance the appearance of the cup lid. As shown in the drawing, the support surface has a generally circular opening with tabs to flex as a straw is inserted in the opening. The opening is on the outer region of the body. Alternatively, an insert can be placed on top of the lid with any desired information. The support surface is a recessed support surface and the body does not include other recesses. Hendler et al. teaches a multi-panel display for use on product packaging. The drawing shows a lid with the display panel attached to the support surface of the lid. Similarly, Crum teaches a container lid 92 comprising a body including a support surface. A medium member 20 separates from the body, the medium member being coupled to the support surface with an adhesive 86. The medium member includes a first portion 80,43,47,64 coupled to the support surface of the body and a second portion 22,23 removably coupled to the first portion. Therefore, it would have been obvious in view of Hendler et al. and/or Crum or Melton to attach an informational member on the lid of Hundley or Smith et al. to indicate the content of the container or to provide advertising material.

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10. Claims 5,12,17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above, further in view of Wolf (US 3,392,468). Mills does not disclose a plurality of flexible buttons. However, Wolf teaches a means in a cup lid to enable a vender to conveniently indicate to a customer the contents of the cup. Wolf has a plurality of flexible dimple 18 that is deformable. The flexible dimples have indicia thereon to indicate the content. Therefore, it would have been obvious in view of Wolf to provide a plurality of dimples or buttons on the cup lid to indicate to the customer the contents within the cup.

### ***Conclusion***

11. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners, M.P.E.P. 203.08.

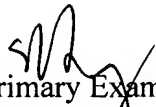
If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Erica Miller at (571) 272-4370.

For applicant's convenience, the official FAX number is **571-273-8300**. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Luong of Art Unit 3728 at the top of your cover sheet of any correspondence submitted.

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Inquiries concerning the merits of the examination should be directed to Shian Luong whose telephone number is (571) 272-4557. The examiner can normally be reached on M-H from 7:00am to 4:00pm EST. The examiner's supervisor Mickey Yu can be reached at (571) 272-4562 for urgent matters.

STL  
May 26, 2006

  
Primary Examiner  
Shian Luong  
Art Unit 3728